



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Venegas, Jr.

Serial No.: 09/597,318

Group No.: 3635

Filed: June 19, 2000

Examiner: W. Yip

For: STANCHION SLEEVE AND METHOD OF USING SAME

APPELLANT'S APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 2 claims. Claims 3-6 were added by amendment in October 2001; claim 7 was added by amendment in September 2002. Claims 5 and 7 were canceled by amendment in November 2003. Claims 1-4 and 6 were canceled, and claims 8-15 were added by amendment in September 2004. Claim 15 was canceled by amendment in February 2005. Claims 13-14 were canceled by Amendment in August 2006. Claims 8-12 are pending, rejected and under appeal. Claim 8 is the sole independent claim.

Adjustment date: 10/19/2007 EAYALEW1
08/03/2006 YPOLITE1 00000066 09597318
02 FC:2402 -250.00 OP

10/19/2007 EAYALEW1 00000098 09597318

01 FC:2402 255.00 OP

IV. Status of Amendments Filed Subsequent Final Rejection

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 8 resides in a cover 14 for a post extending upwardly from a ground surface, the cover consisting of: an elongated, generally cylindrical plastic sleeve having an open lower end 24 and a closed, hemispherically shaped upper end 26. The sleeve has a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches. (Specification, page 4, lines 13-14; page 6, line 15 to page 8, line 14; Figures 5-9)

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

1. The rejection of claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,299,883 to Arth, Jr. in view of U.S. Patent No. 2,450,345 to Kervin.
2. The rejection of claims 8 and 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr.
3. The rejection of claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,812,279 to Voegeli.
4. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,299,883 to Arth, Jr. in view of U.S. Patent No. 2,450,345 to Kervin, or over U.S. Patent No. 3,812,279 to Voegeli, or over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr. as applied to claim 8, and further in view of U.S. Patent No. 3,319,328 to Finger et al.

VII. Argument

1. The rejection of claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,299,883 to Arth, Jr. in view of U.S. Patent No. 2,450,345 to Kervin.

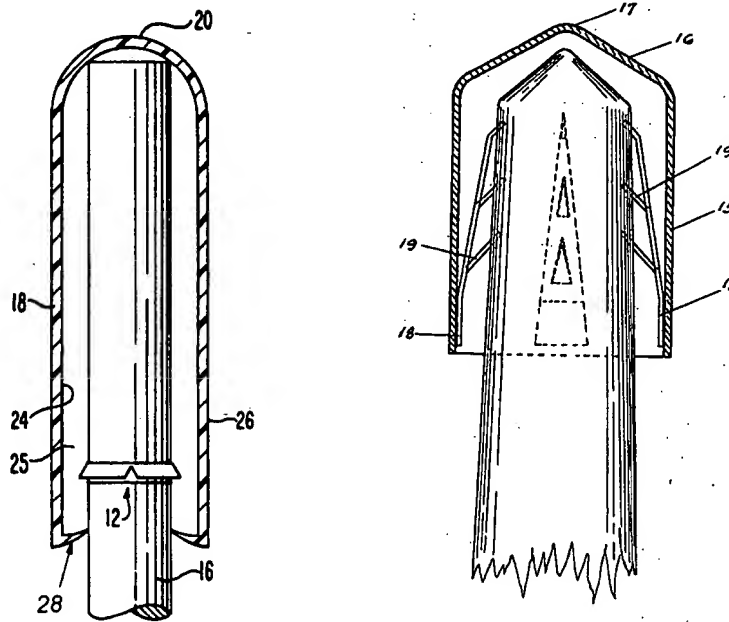
Claim 8 is directed to a cover for a post ... *consisting of:*

“an elongated, generally cylindrical plastic sleeve having an open lower end and a closed, hemispherically shaped upper end; and

the sleeve having a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches."

The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

Claim 8 stands under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,299,883 to Arth, Jr. in view of U.S. Patent No. 2,450,345 to Kerwin. However, BOTH of these references include other essential elements which Appellant's claim purposefully leaves out. Thus apart from there being no convincing evidence that these two patents should be combined, even if they were the "consisting of" mandate would be undermined. The inventions of Arth, Jr. (left) and Kerwin (right) are shown below:



The invention of Arth, Jr.—indeed, the point of novelty of Arth, Jr. is a “lip” 28 that engages with a locking strap 12 to hold the cover on the post 16. (‘883 Patent; 3:64-4:27) The lip/strap combination is *essential* to the Arth invention. The invention of Kerwin—indeed, the point of novelty of Kerwin is “engaging members 18 having their lower ends suitably secured to the cap” (‘345 Patent; 1:46-47). “In the foregoing it will be apparent that one of the essential features is in providing a cap having adjustable means for holding the cap on the end of various sizes or other exposed ends of wood

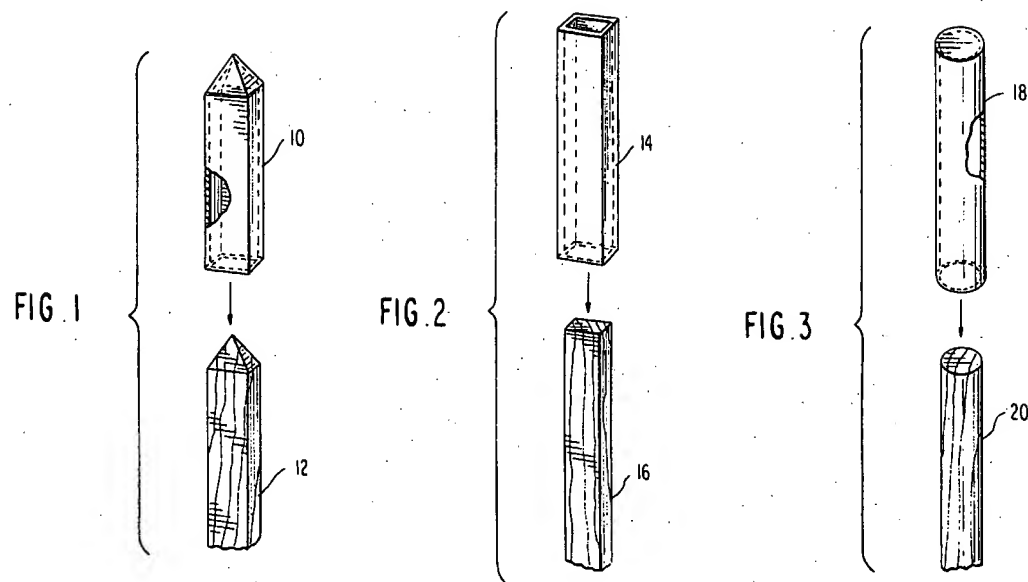
articles to be protected from weather conditions.” (‘345 Patent; 1:10-15). The engaging members 18 are the adjustable means and are therefore essential.

The Examiner’s argument is that it would be obvious to use the engaging members 18 of Kerwin on Arth, Jr. thereby meeting Appellant’s “consisting of” language. This argument is flawed. First, although the engaging members 18 are shown as separate elements in Figures 3 and 4 of Kerwin, this is for illustration purposes only. In all embodiments they are “suitably secured to the cap” *as they would be on the cover of Arth, Jr.* Moreover, as evident in the cross sections of Arth, Jr. the lip is *integrally formed*. Thus, the Examiner cannot somehow “get rid “ of the lip/strap of Arth, Jr. or the engaging members of Kerwin to arrive at a sleeve with neither.

Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Since a cone is not a hemisphere, anticipation has not been established.

2. The rejection of claims 8 and 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr.

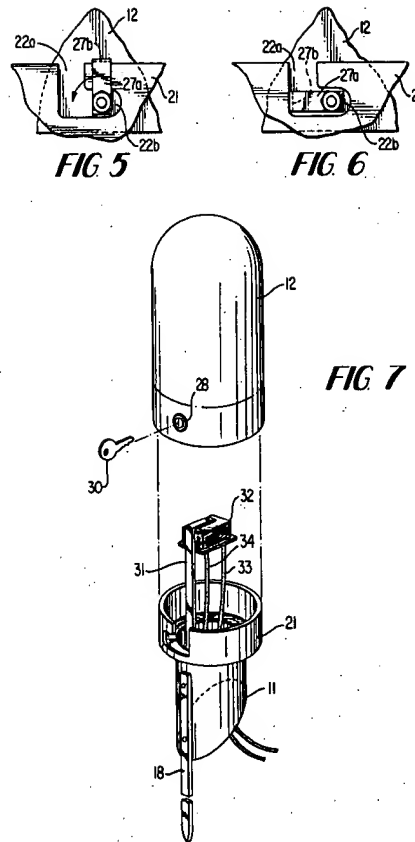
Claim 8 also stands rejected under 35 U.S.C. §103(a) over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr. The Examiner acknowledges that Beatty does not disclose a hemispherical top, but argues that it would have been obvious to combine Beatty with Arth, Jr. “as an obvious matter of design choice.” In all embodiments of Beatty, the inner surfaces of the coverings match the cuts or surfaces made on a wooden post, as on the next page:



Given that Beatty is intended to utilize a top which is *conformal* to flat cuts made at the top of a post, there is nothing obvious about the conversion of a flat top to a hemispherical top, since there are no hemispherically-topped posts disclosed in the '756 patent. Moreover, even if the Examiner's proposed combination were legitimate, the combination includes other essential components, namely, the strap 12 and interlocking inner flared lip of Arth, Jr. Accordingly, *prima facie* obviousness has not been established.

3. The rejection of claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,812,279 to Voegeli.

The invention of Voegeli is depicted on the next page. *Essential* to the invention of Voegeli is a locking mechanism which Appellant's consisting of claim leaves out. The title of the '279 Patent is "CABLE TELEVISION HOUSING WITH LOCKABLY JOINED COVER AND BASE." According to the text of the patent, "FIGS. 3 through 7 of the drawings illustrate the sequence of operation of the *new and novel locking means* as viewed from the interior of the housing. ('279 Patent; 2:21-23, emphasis added). Again, the Examiner cannot just dismiss this essential aspect of the prior art for the purposes of rejection.



4. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,299,883 to Arth, Jr. in view of U.S. Patent No. 2,450,345 to Kervin, or over U.S. Patent No. 3,812,279 to Voegeli, or over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr. as applied to claim 8, and further in view of U.S. Patent No. 3,319,328 to Finger et al.

Claim 12 adds to claim 8 that the sleeve further includes an additive to resist ultraviolet deterioration. The Examiner argues that Arth, Jr. Kerwin, Beatty, and Voegeli teach all [of Appellant's] structural limitations... (Final OA, page 9, ¶5) The problem, as discussed above, it that they teach much more than Appellant's "consisting of" claim. Apart from there being no motivation to combine all of the references, the Finger discloses *a coating* as opposed to *an additive*. "The cap may be treated by coating, dipping or spraying with an ozone resistant material and may be given treatment for protection against ultra violet rays." ('328 Patent; 5:15-17). Thus, even if the Examiner's proposed combination were justified, Appellant's invention would not result.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

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Date: October 16, 2007

APPENDIX A

CLAIMS ON APPEAL

8. A cover for a post extending upwardly from a ground surface, the cover consisting of: an elongated, generally cylindrical plastic sleeve having an open lower end and a closed, hemispherically shaped upper end; and

the sleeve having a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches.

9. The cover of claim 8, wherein the plastic is polyethylene.

10. The cover of claim 8, wherein the plastic is polycarbonite.

11. The cover of claim 8, the sleeve further including an agent to provide a durable coloring throughout.

12. The cover of claim 8, the sleeve further including an additive to resist ultraviolet deterioration.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.